

REMARKS

Claims 1-15 are pending. Applicants elect with traverse Group I (claims 1-4, 8 and 13-15) for examination on the merits. Applicants reserve the right to prosecute non-elected subject matter in a further patent application.

Reconsideration of the restriction requirement is requested. Notwithstanding the above election, Applicants disagree with the allegation in the Action that the pending claims lack unity of invention, and therefore belong to different groups of inventions. Traversal is based on claims 1-15 being so linked as to form a single general inventive concept under PCT Rule 13.1. Here, the special technical feature shared by claims 1-15 under PCT Rule 13.2 is Y11414. Therefore, Applicants request that the pending claims be examined together in this application.

In the alternative, upon an indication that the elected method claims of Group I are allowable, Applicants submit that the product claims directed to polynucleotides (see claim 5), expression cassettes (see claim 9), vectors (see claim 10), host cells (see claim 11), and transgenic plants (see claim 12) would have to be searched and examined as sharing the same special technical feature (e.g., "a Y11414 gene or a functional homologue thereof"). See M.P.E.P. § 1850 III. A. Combinations of Different Categories of Claims (8th Ed., Rev. 3, August 2005) which states at 1800-97 to 1800-98:

The method for determining unity of invention under Rule 13 PCT shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(A) In addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product . . .

[A] process shall be considered to be specially adapted for the manufacture of a product if the claimed process inherently results in the claimed product with the technical relationship being present between the claimed product and claimed process. The words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

The delay in the search and examination of claims 5 and 9-12 would not result in compact prosecution and is not in the public interest because the use of "a Y11414 gene or a functional homologue thereof" to produce a stress-tolerant transgenic plant is

new and patentable. The latter limitation is a special technical feature shared by the claims of Groups I and II. Claims 1-5 and 8-15 should be examined in the same application if the invention of Group I is found to be allowable based on this new and patentable use. Accordingly, the correct grouping of claims should be (i) a first group of claims 1-5 and 8-15 and (ii) a second group of claims 6-7. Therefore, Applicants submit that claims 5 and 9-12 should be included in the invention of Group I that was elected.


If the present requirement is not withdrawn, such that claims 1-5 and 8-15 are searched and examined in this application, the Examiner is respectfully requested to address with particularity why M.P.E.P. § 1850 III. A. does not apply to this application.

Applicants earnestly solicit an early and favorable examination on the merits. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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